

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-13 are pending in the present application and stand rejected. Claims 1, 4, 6, 11, and 13 are being amended to correct a minor antecedent issue. The amendments to Claims 1, 4, 6, 11, and 13 are believed not to change the scope of the subject matter claimed, thus a new search will not be required.

In the outstanding Office Action, Claims 1-13 were rejected under 35 U.S.C. § 112, first paragraph; Claims 1-13 were rejected under 35 U.S.C. § 112, second paragraph; and Claims 1-13 were rejected under 35 U.S.C. §102(e) as being anticipated by Kida (Patent Application Publication US 2006/0092155, hereinafter "Kida").

Turning to the rejection of Claims 1-13 under 35 U.S.C. § 112, first paragraph, Applicants respectfully submit that the arguments presented in the previous response for the same rejection, which arguments are incorporated herein by reference in their entirety, were not responded to by the Office as required in MPEP § 2163.04(II),¹ thus preventing Applicant from further advancing prosecution of this Application. The Office

¹ Upon reply by applicant, before repeating any rejection under 35 U.S.C. 112, para. 1, for lack of written description, review the basis for the rejection in view of the record as a whole, including amendments, arguments, and any evidence submitted by applicant. If the whole record now demonstrates that the written description requirement is satisfied, do not repeat the rejection in the next Office action. If the record still does not demonstrate that the written description is adequate to support the claim(s), repeat the rejection under 35 U.S.C. 112, para. 1, *fully respond to applicant's rebuttal arguments*, and properly treat any further showings submitted by applicant in the reply. When a rejection is maintained, any affidavits relevant to the 35 U.S.C. 112, para. 1, written description requirement, must be thoroughly

is respectfully reminded that "the goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity."²

"[T]he PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by . . . [a] claim is not adequately enabled by the description of the invention provided in the specification . . . this includes . . . providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement. If the PTO meets this burden, the burden then shifts to the applicant to provide suitable proofs indicating that the specification is indeed enabling."

In re Wright, 999 F.2d 1557, 1561-1562 (Fed. Cir. 1993) (also see MPEP 2164.04 – "Burden on the Examiner Under the Enablement Requirement") Applicant respectfully notes that a simple statement requesting where support for a particular claim or portions thereof is found does not meet the noted burden of proof.

In interpreting the foregoing requirements, the BPAI recently stated: "In other words, 'Section 112 does not require that a specification convince persons skilled in the art that the assertions therein are correct.' In re Armbruster, 512 F.2d 676, 678 (CCPA 1975). Instead, 'it is incumbent upon the Patent Office . . . to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and *to back up assertions of its own with acceptable evidence or reasoning which is inconsistent*

analyzed and discussed in the next Office action. (MPEP 2163.04(II), *emphasis added*)

with the contested statement.' In re Marzocchi, 439 F.2d 220, 224 (CCPA 1971)...

Thus, the threshold issue raised by this rejection is not whether Appellants have established that their Specification is enabling ... rather, the issue is whether the Examiner has met his initial burden of providing a reasonable explanation as to why it isn't." (Ex parte Liu et al., Appeal No. 2009-15302 (BPAI), emphasis added)

Applicant further notes that there are no requirements of verbatim support for claim language as well as the provisions of examples or explanations from "*start to finish* instructing one skill in the art of how to construct the instant application without undue experimentation." (See Outstanding Office Action, page 2, emphasis added). Applicant has properly identified previously that support for the amended claims are found in the originally filed claims.

For example, as to Claim 1, for the recitation of (1) "an electronic equipment having a monitor and a device for controlling movement of an icon of a display screen that possesses an instantaneous menu of search;" and (2) "the program generates a three dimensional image showing the shortest and best route to be followed by the user from a point at which the user identifies the desired destination to the desired destination along with notes about the shortest trajectory to be covered by means of an object in movement" please see the following text in bold and underline, respectively, as included in the originally filed Claim 1, i.e.:

Computer oriented way device by three-dimensional image
which aim is to facilitate to the localization of departments,

store, items in exposition, numbered seats and strategic points of great shopping centers, museums, big stores, supermarkets, companies, houses of entertainment, theaters, fairs, events, among others to be located, characterized for being constituted of a computer program, installed in an electronic equipment endowed with monitor and a directive device of the icon of movement of the screen, by touch or voice, that possesses an instantaneous menu of search and searches the place of interest of the user, in different categories of search, so that, when the user informs the place of desired destination, the program generates a three-dimensional image about the shortest and better way to be covered by the user, from the consultation point to the chosen place, followed of notes about the shortest trajectory to be covered by means of an object in movement. (Original Claim 1 as filed from the PCT application.)

As to Claim 6, support is also found in the originally filed Claim 1 as already explained for like recited elements in Claim 1. In addition, Applicant respectfully submits that those of ordinary skill in the applicable arts understand that: (1) the results of an output of a computer program are frequently referred to as a "simulation;" (2) if the user is to receive instruction of how to go from where he or she is to a desired destination, there are first and second points within the place of interest selected by the user; and (3) monitors of most electronic equipment have display screens.

Finally, as to the various paragraphs related to Claim 6 language listed on page 4 of the Outstanding Office Action, Applicant respectfully calls the attention of the Office to the standard language used in a Beauregard-type claim as the same relates to the recitation of subject matter related to software, i.e., a computer program as also recited in the originally filed Claim 1.

As such, Applicant respectfully requests that either (1) the proper procedure be followed for a rejection under 35 U.S.C. § 112, first paragraph for failure to comply with the written description requirement and a response be given to previously submitted argument; or (2) the rejection under 35 U.S.C. §112, first paragraph be withdrawn.

Claims 1-13 were rejected under 35 U.S.C. §112, second paragraph. Applicant has amended Claims 1, 6 and 13 to correct a minor antecedent issue with the recitation of "the place of interest" and to change the expression "net of computers" to "network of computers" in Claims 4 and 11. However, as further explained below, as to the other issues raised in the Outstanding Office Action with respect to this rejection, Applicant respectfully submits that reading of Claims 1-13 as they are is sufficient to particularly point out and distinctly claim the subject matter of the instant invention being claimed therein.

As to the question of "what possesses an instantaneous menu of search" in Claim 1, Applicant respectfully submits that it is the "display screen" that does. That is, the relative pronoun "that" next to the expression "display screen" connects that same term to the restrictive relative clause of "possesses an instantaneous menu of search."

As to the question that it is unclear "how the user identifies the desired destination to the desired destination" in Claim 1, Applicant respectfully submits that the shortest and best route to be followed by the user is from a first point to a second point, i.e., from "a point the user identifies the desired destination" (the first point) to the "desired destination" (the second point).

Finally, as to the question that it is "unclear how a simulation path from the first point to the second point is within the place of interest selected by the user," Applicant respectfully notes that the place of interest may be selected from the group comprising departments, stores, items in exposition, numbered seats and strategic points of great shopping centers, museums, big stores, supermarkets, companies, houses of entertainment, theaters, fairs, and events, as recited in Claim 13. Once the place of interest is identified, the shortest and best route from the first point (the point from which the user is requesting assistance from the system for direction) to the second point (the desired destination) is calculated and displayed to the user.

Applicant respectfully submits that the amendments to Claims 6, 11, and 13 together with the arguments just presented herein have overcome the rejections under 35 U.S.C. §112 second paragraph of Claims 1-13 and respectfully request their withdrawal. It is believed that all pending claims are definite and no further rejection on that basis is anticipated. If, however, the Examiner disagrees, the Examiner is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to derive mutually acceptable language.

Turning to the anticipation rejections, Applicant respectfully submits that Claims 1 and 6 are not anticipated by Kida because each and every element as set forth in that claim is not found, either expressly or inherently described, in the cited reference. In an

anticipation rejection, the identical invention must be shown in as complete detail as is contained in the claim.³

According to a feature of the invention as set forth in Claims 1 and 6, a three-dimensional image is recited showing the shortest and best route *by means of an object in movement*. Kida does not expressly or inherently describe such an advantageous feature; therefore it cannot anticipate Claims 1 and 6.

In its rejection of Claims 1 and 6 now, the Office states that paragraphs [0140], [0210], [0211], and [0219] of Kida anticipates the noted subject matter of Claims 1 and 6. Applicant respectfully disagrees and submits that an element-by-element indication to substantiate such a conclusory statement has not been provided. Consider as an example, but not as a limitation to Applicant's ability to argue such an unsubstantiated conclusion, in none of the listed paragraphs of Kida one finds any disclosure expressly or inherently describing the generation of a three-dimensional image showing the shortest and best route *by means of an object in movement*.

In the newly cited paragraphs of Kida arrows indicating the direction of travel are displayed. As further explained in paragraph [0210] of Kida "the 3D map/information superimposed displaying portion 2 displays the path which the user should currently follow (step S69 in FIG. 27) (see FIG. 32). In FIG. 32, *an arrow 20103 in the center of the screen indicates the direction that the user should follow.*" Applicant

³ See MPEP 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (Citations omitted) (emphasis added). See also

respectfully submits that an arrow indicating a direction of travel of a user movement is not (expressly or inherently) the recited feature of a means of an object in movement. Applicant further respectfully submit by way of example and not of a limitation that those of ordinary skill in the applicable arts understand that in the present disclosure the means of an object in movement may be represented by a 3D animation or movie of a trajectory to be followed by a user from a starting point to a desired destination within an actual place of interest showing a realistic rendition of all details of an actual route to be followed.

Applicant respectfully submits that Claims 1 and 6 are not anticipated by Kida. This cited prior art reference does not disclose expressly or inherently the generation of a three-dimensional image as recited in these claims. Claims 2-5 and 7-13 should be allowed, among other reasons, as depending either directly or indirectly from Claims 1 and 6, respectively, which should be allowed as just explained.

In addition, Claims 2-5 and 7-13 are further considered allowable as they recite other features of the invention that are not disclosed, taught, or suggested by the applied reference when those features are considered within the context of the subject matter recited in independent Claims 1 and 6. For example, Claim 2 recites the advantageous feature of execution in real time. Contrary to what has been asserted by the Office, Kida is silent to any execution in real time in paragraphs [0034], [0043], and [0113]. Similar arguments can be presented to the rejection of Claims 3-5 and 7-13.

Therefore, Applicant respectfully requests that the anticipation of Claims 1-13 under 35 U.S.C. §102(e) be withdrawn.

Accordingly, in light of the above discussion and in view of the enclosed amendments, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested. If, however, there are any remaining unresolved issues that would prevent the issuance of the Notice of Allowance, the Examiner is urged to contact the undersigned at (832) 247-8181 in order to expedite prosecution of this application.

Respectfully submitted,

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